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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,926	07/17/2003	David Elberbaum	ELBX 18.829A	2572
26304	7590	07/14/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN			CHAN, WING F	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			2643	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/621,926

Applicant(s)

ELBERBAUM, DAVID

Examiner

Wing F. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

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Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/17/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-42 of U.S. Patent No. 6,603,842. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are directed to the same apparatus for connecting a television interphone monitor system to an E concierge station via a communication network.

As can be seen from a comparison of applicant's claim 1 and patent claim 33, present claim 1 includes the matrix selector comprising digital switches, while this is not recited in patent claim 33.

As set forth in *In re Vogel* 164 USPQ 619, the specification can be used as a dictionary to learn the meaning of terms used in the patent claims. Since the present application is a continuation of U. S. Patent No. 6,603,842, the patent disclosure and the present application both clearly describes the functions and limitations, which are encompassed by the claim's comprising format. The 842 patent in col. 6, lines 9-18, for

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example, reference is made to the switches S1 and S2 of the matrix selector can be "electronic analog or digital switches or matrix switches", in view of this definition of the patentee, the matrix selector can comprise matrix switches, analog switches and digital switches. Therefore, to further define the matrix selector switches to be digital switches is deemed obvious over patent claim 33 since the functions are clearly set forth in the specification to be the same as that of patent claim 33.

In view of the above analysis applicant's claim 1 and patent claim 33 are not patentably distinct from one another and in the absence of a terminal disclaimer would result in possible harassment by multiple assignees.

Dependent claim 2 corresponds to patent claim 34 verbatim; therefore it need not be addressed.

The above analysis also applies to the other pending claims in a manner similar to claims 33, 34 above. Hence, applicant's claims 1-40 and patent claims 33-42 are not patentably distinct from one another and in the absence of a terminal disclaimer would result in possible harassment by multiple assignees.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is 703-305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to read "Wing F. Chan". The signature is fluid and cursive, with the first name "Wing" and last name "Chan" clearly distinguishable.

WING F. CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

WFC
7/6/04

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